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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,035	10/24/2003	James K. Sankey	1007-NO-CONT	1756
27542	7590	03/07/2005	EXAMINER	
SAND & SEBOLT AEGIS TOWER, SUITE 1100 4940 MUNSON STREET, NW CANTON, OH 44718-3615			FOSTER, JIMMY G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,035

Applicant(s)

SANKEY ET AL.

Examiner

Jimmy G Foster

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-13,16 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-13,16 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3728

1. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This application is a continuation of application serial No. 904,264 and therefore may not include new matter over the original disclosure of the parent application. The added limitation to claim 1, calling for the locking fingers to be spaced from the top surface of the base by a distance that is greater than a standard CD, is not supported by the original disclosure. While Figure 13 clearly shows a locking finger (60) being spaced by from the top surface/seating area 25 of the base 12 by a distance greater than the item of recorded media 22, there is no disclosure that this distance is greater than the thickness of a standard CD since the disclosure does not indicated that the item 22 is a standard CD. Accordingly, said added limitation to claim 1 constitutes new matter. Moreover, there is no original disclosure regarding what would be the thickness of a standard CD. Accordingly there would be insufficient description to support the subject matter of claim 1.

2. Claims 1-7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Inasmuch as Applicant's disclosure identifies no standard for a CD thickness, inasmuch as

Art Unit: 3728

there may are may not be only one standard, and inasmuch as standards may change from year to year, a limitation regarding a space being greater than a thickness of a standard CD is indefinite because it is not clear what particular thickness is being required by the claim.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 7 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Wong et al (6,283,280). The hub of Wong et al is readable on Applicant's claimed hub, insofar as claimed, and may be considered to include the combination of the tube portion 2 and the locking knob portion 4, and therefore may be considered to extend from the base 11,21 of the container (box 1).

A continuous vertical sidewall (unnumbered) of the knob portion 4 constitutes a sidewall of said hub, insofar as claimed. The sidewall includes outwardly extending flexible/elastic locking fingers/wings 44 which

Art Unit: 3728

have a height less than the height of said sidewall. The wall may be said to be continuous since it continuously extends around the periphery of the knob portion of the hub. When the knob 4 is locked/tightened onto the tube 2, as described in column 3, lines 18-33, said vertical sidewall of knob 4 may be said to be fixed with respect to the base 21.

In addition, the device of Wong et al includes a base at 11 and a lid as shown in Figures 1 and 2.

It is possible to make a disc-shaped item of recording media with a central opening that is not circular. Moreover, there is no definitional or functional requirement that a disc-shaped item of recording media have a circular shape for its central opening. Inasmuch as Applicant has not positively recited the media and characteristics thereof as structure in the claims, the examiner asserts that the flexibility of the flexible finger 44 of Wong et al makes the finger inherently capable of flexed so as to permit an appropriately sized and shaped opening of a disc-shaped media to be forced down over the hub 2,4, with the finger 44 becoming disposed on top of the disc-shaped media.

Regarding Applicant's claim 21, the claim fails to provide a structural relationship between the disc-shaped item called for in claim 1 and the disc shaped item set forth in claim 21. Inasmuch as the hub 2,4 of Wong et al is used for retaining CD's (e.g. ref num. 5) underneath part 4, claim 21 fails to distinguish over Wong et al.

5. Claims 1, 6, 7, 9 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Brien et al (5,819,926). The reference of O'Brien shows a

Art Unit: 3728

hub at central core 22, which is connected to a base (20,32), wherein the hub includes a sidewall (e.g. at 42) that is unmovable, fixed and rigid, as indicated from a contrast of Figures 7 and 8, and wherein the hub includes plural integral flexible fingers/detents 38 attached to the sidewall 24 thereof. The hub will retain a disc-shaped media item 50 in a seating area of the base, as indicated in Figure 4. In the device shown in Figure 3 of the reference, the sidewall of the hub may be considered to be continuously cylindrical, as evident from the figure, even though there are cutouts in the sidewall by which to form the detents.

Additionally, there is provided a lid 16 which closes on the base and the seating area of the disc-shaped item (col. 6, lines 25-28).

Although the reference shows the flexible fingers as remaining bent and within the opening of the disc-shaped media during disc retention, instead of being disposed over the top of the disc-shaped media, Applicant does not positively recite the disc-shaped media in the claims as structure but as intended use. Moreover, although Applicant's claims refer to a thickness of a standard CD, Applicant also therefore does not positively recite a CD which as a standard thickness as structure in the claim. Inasmuch as the fingers 38 of the O'Brien et al reference are capable of being disposed over a disc-shaped media item which is thinner than the gap between the bottom of the finger shown in Figure 8 and the top surface of the portion 32 of the base 30,32 (since the thinner disc-shape would be able to move past the ends of the fingers), what Applicant has claimed regarding forcing the media down over the hub until the fingers are disposed over the media, does not distinguish over the subject matter of O'Brien et al. Moreover, inasmuch as such a thin disc-shaped media would be capable of being used as a standard,

Art Unit: 3728

Applicant's limitation regarding a standard CD also does not distinguish over the subject matter of O'Brien.

As shown in Figure 1, the hub is tubular and open at the bottom of the base.

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-5, 10-13, 16, 19, 20, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien et al (5,819,926) in view of Dean (6,123,191). Although the reference of O'Brien et al does not disclose the fingers 38 as becoming disposed over the top of the disc-shaped media, the reference of Dean, at 34 and along with the paragraph regarding operation at column 3, lines 1-22, suggests that the integral flexible peripheral portion (34) of a hub for engaging the opening in a disc-shaped media may be located closer to the top of the sidewall of the unmovable post portion of the hub, for the purpose of providing a sufficiently high location on the side wall to permit the disc-shaped media to be captured under the flexible portion. Disposal of the flexible portion (34) over the top of the disc-shaped item would provide blocking interference between the disc-shaped item and the flexible portion (34), thereby preventing inadvertent removal of the disc-shaped item from the base (20). Accordingly, it would have been obvious in view of Dean to have located the flexible portions/fingers 38 of O'Brien et

Art Unit: 3728

al at the top of the sidewall 22,42 so as to permit the disc-shaped item to fully move past the fingers and permit the fingers to provide blocking interference against inadvertent removal of the disc-shaped item 50.

In addition, the reference of Dean suggests that the sidewall of a hub may have a continuous cylindrical shape. As apparent in Figures 4 and 8 of Dean, the cylindrical shape of the side wall avoids acting as a wedge against the inner edge of the central opening of the disc-shaped media item and therefore will not interfere with installing the disc on the hub under the flexible portion (34). Accordingly, the reference of Dean suggests that the continuous cylindrical shape of the side wall of a hub is a suitable shape when the disc-shaped media item is to be captured beneath a flexible bending portion (34) on the hub. Therefore, for these reasons, it would have further been obvious in view of Dean to have made sidewall (42 etc.) of the hub of O'Brien et al, as modified above, cylindrical in shape.

Although the reference of Dean as applied to O'Brien et al does not disclose making a flexible portion (34) of a hub (30) with an upper surface that is coplanar with respect to the upper surface of the sidewall of the hub (30), Applicant has not disclose a reason for the particular configuration, and the examiner does not see a difference in function of a coplanar upper surface over an upper surface that is not coplanar. Inasmuch as a mere change in shape is generally recognized as being within the level of ordinary skill in the art (See In re Dailey et al., 149 USPQ 47; See also In re Seid, 73 USPQ 431), it would have been obvious to have made the fingers of O'Brien et al, as modified in view of Dean above, with any workable particular shape, including that as claimed by Applicant, which will capture the disc-shaped media in the manner as taught by Dean.

Art Unit: 3728

In addition, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). The general conditions regarding the sidewall and the locking finger of Applicant's claims are met by the teachings of O'Brien et al and Dean. Accordingly, it would have been obvious to have discovered desirable values or ranges, such as claimed, for the heights of the sidewall and the locking finger.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 9-13, 16, 19, 20 and 22-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-17 of U.S. Patent No. 6,698,586 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims either include or suggest all of the subject matter set forth in the present claims, including that about a base, a lid, a seating area, a hub, a continuously cylindrical, unmovable hub sidewall having a $\frac{1}{16}$ inch height, a flexible locking finger adapted to be disposed over the disc-shaped item, a finger height of .01 inches and being of $\frac{1}{4}$ to $\frac{1}{12}$ of the height of the side wall, except for claim 22 which calls for the

Art Unit: 3728

hub to be tubular and open at a bottom. However, official notice is taken that it is known to make a hub with an open bottom, which would require less material than a solid hub. Accordingly, it would have been obvious in view of this to have made the hub of patent claims 12-17 with an open bottom.

10. Applicant's arguments filed 23 December 2004 have been fully considered but they are not persuasive. The knob 4 of Wong et al includes a side wall integral with the locking fingers. Accordingly, Applicant's argument regarding Wong et al appears to be incorrect.

Since a CD may be any size, any size may become a standard, and any CD thickness may become a standard. Accordingly, Applicant's limitation regarding a standard CD is insufficient to overcome O'Brien et al.

Applicant's argument that modifying O'Brien to be as Dean with respect to the flexible projection/finger would render O'Brien unsuitable for its intended purpose. The examiner disagrees since the combination would still be capable of retaining a CD on a hub. Moreover, the passage of column 2, lines 44-52 of O'Brien does not indicate that fingers on top of the CD will be undesirable. O'Brien disclosure regarding the detents 38 does not teach away, it just teaches *different* - which is not the same thing.

Applicant argues that the references do not disclose a *result-effective variable* (or general condition), regarding heights of the side wall and locking fingers, in order to be able to hold that discovery of optimum or workable ranges or values would have been within the ordinary skill in the art. Applicant is wrong. The references disclose fingers having heights, sidewalls having heights, and fingers/retainer detents whose heights are portions of the heights of the side wall, even when the fingers will be disposed over the item of recording media. Therefore, the applied

Art Unit: 3728

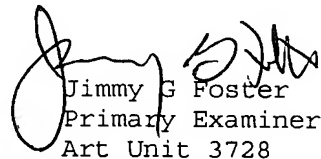
prior art includes the necessary result-effective variables regarding these height and relative height dimensions. Applicant would do much better by trying to persuasively show that the change in dimensions constitute a change in kind and not degree.

11. This action is not made final since the obviousness-type double patenting rejection is a new ground of rejection, which could have been made in the first Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (571) 272-4554. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Jimmy G Foster
Primary Examiner
Art Unit 3728

JGF
3 March 2005